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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,585

03/18/2004

Kathleen Nylund Jackson

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EXAMINER

HU, KANG

ART UNIT

PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/804,585

Applicant(s)

JACKSON, KATHLEEN NYLUND

Examiner

Kang Hu

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01/08/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The amendments to the claims and specification along with the arguments have been entered on 1/8/2007.

#### *Specification*

2. The disclosure is objected to because of the following informalities:

Page 11, line 3: "rata" should be -- rate --, "four" should -- for --.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 10 and 15 recite the limitation "further comprising excluding the player who received the jackpot from entering the special bonus events." in lines 1-2 which contradict applicant's independent claim which states "entering a special bonus event for at least all of said players presently playing the underlying wagering game" in line 7 of claim 1. Claims 10 and 15 contradict the independent claim of allowing all of the players presently playing the underlying wagering game to enter the secondary bonus, making the claims non-enabling.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Luciano, Jr. et al. (US 6,887,154).

Re claim 1: Luciano discloses a method of playing a gaming system played by a plurality of players where a jackpot is awarded, the method comprising: players playing an underlying wagering game in which wagers are made by players; when an outcome occurs in the underlying wagering game that identifies that a jackpot is to be awarded to at least one of said players, entering a special bonus event for at least all of said players presently playing the underlying wagering game (see col 9, lines 18-26); the special bonus event providing a chance to be awarded bonuses; and randomly awarding bonuses to some of the at least all players in addition to any awards the some of the at least all players may win during continued play of the underlying wagering game (col 1, lines 5-67; col 2, lines 25-67; col 3, lines 1-13; col 4 - col 6).

Re claim 2: Luciano discloses the underlying game is a casino table game (col 5, lines 26-32).

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Re claim 3: Luciano discloses the underlying game is played on a slot-type wagering apparatus (col 5, lines 26-32).

Re claim 4: Luciano discloses the slot-type wagering apparatus is a networked wagering apparatus (col 4, lines 37, see fig 1).

Re claim 5: Luciano discloses the jackpot is a progressive jackpot (col 4, lines 42-47).

Re claims 6-8: Luciano discloses the bonuses do not decrement the jackpot (col 3, lines 13-20).

Re claims 9 and 11-14: Luciano discloses the bonuses are awarded to more than one but less than all players (col 2, lines 47-54).

Re claim 10 and 15: Luciano discloses further comprising excluding the player who received the jackpot from entering the special bonus events (abstract, col 4, lines 29- 67).

Re claims 16 - 20: Luciano discloses the bonus is selected from the group consisting of immediate random bonus awards, immediate play bonus awards, mini-jackpot awards, free play awards, electronic game tickets, physical game tickets, and combinations thereof (col 4, lines 56-59; col 9, lines 26-36).

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Re claim 21: Luciano discloses a method of playing a gaming system played by a plurality of players where a jackpot is awarded, the method comprising: players playing an underlying wagering game in which wagers are made by players; when an outcome occurs in the underlying wagering game that identifies that a jackpot is to be awarded to at least one player, entering a special bonus event for at least all players presently playing the underlying wagering game; and randomly awarding bonuses to some of the at least all players in addition to any awards the some of the at least all players may win during continued play of the underlying wagering game, wherein the bonuses to some of the at least all players is based upon a progressive bonus jackpot (col 2, lines 46 - 49; col 3, lines 1-13).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano in view of Adams et al. (US 5,743,798). The teachings of Luciano have been discussed above.

Re claim 22: Luciano teaches a method of playing a gaming system played by a plurality of players where a jackpot is awarded, the method comprising: players playing an underlying wagering game in which wagers are made by players; when an outcome occurs in the underlying wagering game that identifies that a jackpot is to be awarded to at least one player, entering a

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special bonus event for at least all players presently playing the underlying wagering game; and randomly awarding bonuses to some of the at least all players in addition to any awards the some of the at least all players may win during continued play of the underlying wagering game, wherein the bonuses to some of the at least all players is based upon a progressive bonus jackpot.

However Luciano did not expressly disclose the jackpot awarded is not a progressive jackpot.

Adams teaches a method and apparatus for playing a roulette game including an optional progressive jackpot bonus (col 2, lines 15-20).

Therefore in view of Adams, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a regular jackpot followed by an optional progressive bonus jackpot. It is well known to one of the ordinary skilled in the art that the participation drops after a jackpot has been won. The casinos have always awarded the active players with comps to keep the players interested and engaged in the game. It would have been obvious for the casinos to group the prizes together and increase participation by adding an additional progressive jackpot bonus after a regular jackpot to keep the players interested and engaged.

Luciano and Adams are analogous art because they are from the same field of endeavor of progressive jackpot gaming methods.

***Response to Arguments***

Applicant's argument, filed January 8<sup>th</sup>, 2007 have been fully considered but are not persuasive.

The applicant's amended abstract is acceptable for the proper language and format.

The applicant did not fully amend the specifications to fix the typographical errors. The objection to the specification is maintained.

The Applicants arguments in regards to the 35 U.S.C. 112 rejections are not persuasive therefore the rejections are maintained. The examiner maintains the 112 rejections of claims 10 and 15 for non-enabling. Claim 1 recites the limitation "entering a special bonus event for at least all of said players presently playing the underlying wagering game" in line 7. Claims 10 and 15 recite "further comprising excluding the player who received the jackpot from entering the special bonus event". The amended claims still do not make claims 10 and 15 enabling to one of the ordinary skill in the art. For example, if the independent claim claims there are four legs on a chair and all the legs are attached to the chair, the dependent claim cannot logically state that there are now less than four legs on the chair.

In response to the applicant's argument that the prior art reference is different than what the applicant has claimed as the invention in the 102, 103 rejections, it is noted that the two steps qualification for being awarded the bonus by the random distribution as claimed in 1 and 21 are given their broadest interpretation in light of the specification. The prior art reference does provide a random distribution for the secondary bonus as stated in col 1 of "random



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determination by the progressive controller". Also as cited by the examiner, the secondary bonus prize may also come from a pool of expired prize, points, coupons or credits. The system relies upon a random distribution system to redistribute secondary bonuses to active players.

In regards to the applicant's argument that Luciano does not provide the chance to be awarded a bonus as the bonus (the secondary progressive) is automatically awarded to all players, the examiner acknowledges the argument made by the applicant and respectfully disagrees with the applicant. According to col 2, lines 47-48, "an active status player may be eligible to share in a one or more secondary progressive prizes" Luciano provides the chance to award the active players with one or more prizes. The chances determine if the player will or will not receive a prize, it also determines how many prizes and the type of prizes the player will be receiving. In claim 1, the applicant has stated "randomly awarding bonuses to some of the at least all of said players". The applicant's argument in regards to the "some of the at least all" is moot, if "all" of the players receive a bonus, then "some" receive it as stated in the prior art reference by Luciano, Jr. et al.

In response to applicant's argument that the reference fails to show less than all of the players are eligible to win the secondary progressive prize for claims 9 and 11-14. It is noted that the applicant disagrees with the examiner on the citation provided in col 2, lines 47-54. The cited portion does not say that all of the players will receive a bonus; it only provides that the active status player may be eligible to share in one or more secondary bonus. As understood by the examiner that means that not everyone will be awarded a bonus.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kang Hu whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KH/  
Kang Hu  
March 12, 2007

  
**KIM NGUYEN**  
**PRIMARY EXAMINER**